

Remarks

This is in response to the Examiner's communication mailed May 7, 2003. A response was due August 7, 2003. Enclosed herewith please find a petition for a one-month extension of time. A response with a one-month extension of time is due September 7, 2003. Accordingly, this response is being timely filed.

As a preliminary matter, applicant notes that the May 7, 2003 Office Action indicates that claims 1-24 are currently pending. The Office Action is in error. In the amendment filed February 5, 2003, applicant added a new claim, claim 25. Claim 25 is dependent from claim 1. Accordingly, claims 1-25 are pending.

Claims 1, 2, and 4-15 have been rejected under 35 U.S.C. § 103 as being unpatentable over Baker et al (U.S. patent No. 5,821,636) in view of POWERWARE 5140. Specifically, the Examiner alleges that Baker et al. discloses all the features of claim 1 except for at least one output connection adapted to be hardwired to a piece of equipment to provide electrical power, and that it would be obvious to provide such a connection in view of POWERWARE 5140, which shows a device having a plurality of electrical output assemblies including at least one output connection adapted to be hard-wired to a piece of equipment. Claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Baker et al. in view of POWERWARE 5140 as applied to claim 1 above, and further in view of Kozlowski et al (U.S. Patent No. 5,747,734. Claims 16-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Baker et al. in view

of POWERWARE 5140 as applied to claim 1 above, and further in view of Domigan (5,675,194).

Applicant respectfully traverses the rejections as they relate to the present claims.

Applicant submits that the Office Action has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. For example, the Office Action fails to indicate where in the prior art, a suggestion or motivation is provided to modify the teachings of Baker et al. and POWERWARE 5140 to obtain the power distribution units recited in the present claims. Absent such an indication, applicant submits that the rejections under 35 U.S.C. § 103 cannot be maintained. The motivation or suggestion to support a rejection under 35 U.S.C. § 103 must be clear and particular (*In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); emphasis added), and "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed" (*In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). Applicant respectfully submits that the prior art fails to provide a clear and particular showing that one of ordinary skill in the art would have been motivated to modify the teachings of Baker et al. with POWERWARE to obtain the claimed power distribution units. Absent such a clear and particular indication, the rejections under 35 U.S.C. § 103 cannot be maintained.

In addition, as discussed herein, applicant submits that the combination of references actually teaches away from the

present invention. It is well established that a reference must be interpreted as a whole, and cannot be picked apart to deprecate an invention (*In re Fine*, 837 F.2d 1071, 1075, (Fed. Cir. 1988)). "As a general rule, references that teach away cannot serve to create a prima facie case of obviousness." (*McGinley v. Franklin Sports, Inc.* CAFC 8/21/01 citing *In re Gurley*, 31 USPQ2d 1131, (Fed. Cir. 1994)).

Both the claimed invention and the invention of Baker et al. are power distribution units (PDUs), in contrast to the POWERWARE 5140, which is an uninterruptible power supply (UPS). Thus, the POWERWARE 5140 constitutes nonanalogous art to the present invention, and its teachings cannot properly be applied to the disclosure of Baker et al. Thus, applicant submits that one of ordinary skill in the art would not be motivated to combine the teachings of POWERWARE 5140 for a UPS with the teachings of Baker et al. for a power distribution unit for any purpose, let alone for the purpose of attaining the present invention. This lack of motivation is discussed further herein.

The differences between PDUs and UPSs are well understood by persons of ordinary skill in the art. Among other things, a PDU does not include any internal power source, such as a battery, while a UPS, such as the POWERWARE 5140, in direct contrast requires an internal battery that acts as a power reserve in the event of a power outage (see, for instance, pages 2 and 18-22 of the POWERWARE 5140 User Guide). The fact that a PDU is separate, distinct, nonanalogous to and not interchangeable with a UPS is underscored on pages 17 and 25-27 of the POWERWARE 5140 User Guide, which explicitly show that the PDU is an optional piece of equipment usable with, but separate

from, the UPS. Thus, one of ordinary skill in the art would not be motivated and would not find it obvious to incorporate features of the POWERWARE 5140 into a PDU.

Indeed, if one of ordinary skill in the art were to turn to the POWERWARE 5140 User Guide in search of teachings relevant to a PDU of the type disclosed by Baker et al, he or she would skip over the portions of the guide describing the UPS, and would focus solely on the optional PDU shown in FIG. 15 of the guide. The disclosed PDU in FIG. 15 has only two, low voltage receptacle outlets, and the disclosed PDU does not include at least one output connection adapted to be hard-wired to a piece of equipment. Thus, if anything, the POWERWARE 5140 User Guide shows that it is NOT obvious to provide a PDU with a hard-wired output connection and actually teaches away from providing a hard-wired output connection with a PDU. In addition, applicant submits that POWERWARE 5140 suggests that, if such a connection is desired, it should be provided on a UPS separate from and usable with the PDU, rather than on the PDU itself.

Simply put, the present invention, in particular as recited in claims 1, 2 and 4-15, is unobvious from and patentable over Baker et al. in view of POWERWARE 5140 under 35 U.S.C. 103 (a).

Regarding Kozlowski et al., and the rejection of claim 3, applicant submits that Kozlowski et al has been cited merely to show that a housing for electrical equipment may include front and back access doors, and does not show a PDU having an electrical power input assembly and a plurality of electrical power output assemblies including at least one output connection adapted to be hard-wired to a piece of equipment and at least

one receptacle adapted to receive an equipment plug to provide electrical power.

Kozlowski et al. does not supply the differences apparent in Baker et al. and POWERWARE 5140. Accordingly, the rejection of claim 3 as being obvious over Baker et al in view of POWERWARE 5140, and further in view of Kozlowski et al, is improper for the reasons discussed above in connection with the rejection of claims 1, 2, and 4-15, and should be withdrawn.

Similarly, with respect to the rejection of claims 16-24, the patent to Domigan has been cited to show that a plurality of PDUs may be connected to one another. Thus, the Examiner alleges that it would be obvious to modify the teachings of Baker et al. with the teachings of Domigan such that a plurality of PDUs are interconnected for the purpose of providing a modular power distribution system through a structure such as a building. However, neither Baker et al. nor Domigan show a PDU having an output connection adapted to be hard-wired to a piece of equipment. Accordingly, the combination of Baker et al. and Domigan does not possess or even suggest all the features of the claimed invention. Moreover, the features of the POWERWARE 5140 can not properly be combined with either Baker et al. or Domigan for the reasons discussed above in connection with the rejection of claims 1, 2, and 4-15.

Thus, applicant submits that the present invention, and in particular claims 16-24, are unobvious from and patentable over Baker et al. in view of POWERWARE 5140 and further in view of Domigan under 35 U.S.C. 103(a). Accordingly, the rejection of Claims 16-24 is improper, and should be withdrawn.

Applicant submits that each of the present dependent claims is separately patentable over the prior art. For example, none of the prior art disclose, teach, or even suggest the present power distribution units including the additional feature or features recited in any of the present dependent claims. Therefore, applicant submits that each of the present claims is separately patentable over the prior art.

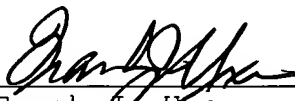
In view of the above, applicant submits that the present claims, and in particular claims 1-25, are unobvious from and patentable over the combinations of Baker et al. in view of POWERWARE 5140; Baker et al, in view of POWERWARE 5140 further in view of Kozlowski; and Baker et al. in view of POWERWARE 5140 and Domigan under 35 U.S.C. § 103.

In conclusion, applicant has shown that the present claims are unobvious from and patentable over the prior art under 35 U.S.C. § 103. Therefore, applicant submits that the present claims, that is claims 1-25, are allowable. Therefore, applicant requests the Examiner to pass the above-identified application to issuance at an early date. Should any matters

remain unresolved, the Examiner is requested to call (collect) applicant's attorney at the telephone number given below.

Respectfully submitted,

Date: September 8, 2003

  
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Frank C. Uxa  
Attorney for Applicant  
Registration No. 25,612  
4 Venture, Suite 300  
Irvine, California 92618  
(949) 450-1750  
(949) 450-1764 Facsimile